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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/633,385 | 08/01/2003 | David E. Wolf | 205-010US2 | 2826 |
| 27791 | 7590 | 08/14/2006 | EXAMINER PUNNOOSE, ROY M | |
| ALLISON JOHNSON, P.A. LAKE CALHOUN EXECUTIVE CENTER 3033 EXCELSIOR BLVD., SUITE 467 MINNEAPOLIS, MN 55416 | | | ART UNIT 2877 | |

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CA

| | | | |
|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/633,385 | Applicant(s) WOLF ET AL. | |
| | Examiner Roy M. Punnoose | Art Unit 2877 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-24, 38, 48-52, 57, 58, 61-64 and 70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 70 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-24, 38, 48-52, 57, 58 and 61-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Election

1. Applicant's election of claims 1-9, 11-24, 38, 48-52, 57-58, 61-64 and 70 filed on May 19, 2006 in response to the restriction requirement based on original presentation is acknowledged and has been entered into the records. However, upon careful consideration of the claims and further prior art search, new prior art relevant to the applicant's claimed invention has been discovered, which is the subject of this office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Soini et al (US_6,204,068).

4. Claim 1 is rejected because Soini et al (Soini hereinafter) teaches of a fluorescence correlation instrument comprising: a sample flow chamber 4 (see col.5, line 16), an excitation source 1, at least one of a light focusing element 2a positioned to receive light emitted by said excitation source 1, a detector 9, 10, 11 for detecting light, said detector 9, 10, 11 positioned to receive light emitted by a sample 3 excited by said excitation source 1 and a correlator 12 (see col.6, lines 14-17) coupled to said detector 9, 10, 11, said correlator for processing data received at said detector 9, 10, 11 and providing data comprising autocorrelation data, cross-correlation data, or a combination thereof (see col.6, lines 2-21 and Figure 1).

5. Claim 4 is rejected because Soini teaches of an aperture 6 (see col.6, line 11) positioned to receive light emitted by a sample 3 excited by said excitation source 1.

6. Claim 5 is rejected because Soini teaches of light focusing element comprising a focusing lens 2a (see col.6, line 9).

Claim Rejections - 35 USC § 103

7. Claims 2-3, 6-9, 11-24, 38, 48-52, 57-58 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soini et al (US_6,204,068) in view of what is commonly known in the art.

8. Claims 2-3, 6-9, 11-24, 38, 48-52, 57-58 and 61-64 are rejected because:

- A. Soini teaches all claim limitations as disclosed above in a fluorescence correlation instrument for measuring fluorescence of a sample under test.
- B. The Examiner takes official notice that all the features claimed in the above dependent claims are taught by prior art that is well known in the art in a fluorescence correlation instrument for measuring fluorescence of a sample under test.
- C. In view of what is well known in the art, it would have been obvious to one of ordinary skill in the art to incorporate the limitations that are well known in the art to Soini's teachings due to the fact that such a combination of limitations would provide an instrument that has increased and enhanced capabilities art in a fluorescence correlation instrument for measuring fluorescence of a sample under test.

Allowable Subject Matter

9. Claim 70 is allowable because none of the prior art documents disclose a fluorescence correlation instrument for measuring fluorescence of a sample comprising a second light

focusing element, and the optical fiber having a first end disposed in the sample chamber and the second light focusing element being focused on the first end of the optical fiber, in combination with the rest of the limitations of claim 70.

Conclusion/Status Information

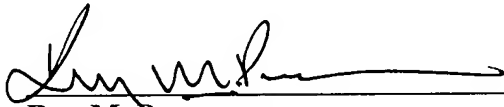
10. Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice in this office action. Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); In re Fischer, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not seasonably traverse the well-known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the **next reply** after the Office action in which the well known statement was made.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**. The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 07, 2006


Roy M. Punnoose
Patent Examiner
Art Unit 2877